Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte PAUL SIDIKMAN
and
LAWRENCE D. WEISS

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MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES
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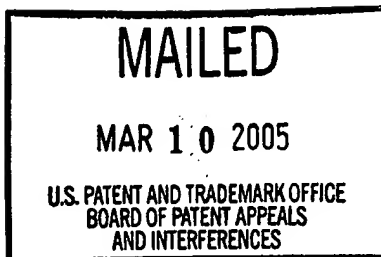
Appeal No. 2005-0278
Application No. 09/006,839

ON BRIEF

Before FRANKFORT, NASE, and DIXON, <u>Administrative Patent Judges</u>.

NASE, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 19 to 37, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method and a system for providing

brokerage services through a network of automated teller machines (specification, p. 1).

A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 19 to 37 stand rejected under 35 U.S.C. § 102(a) based upon a public

use or sale of the invention as discussed in article entitled "Trade It Yourself Bank

Machines Make a Debut," Los Angeles Times, October 6, 1994 (the LA Times Article).

Rather than reiterate the conflicting viewpoints advanced by the examiner and

the appellants regarding the above-noted rejection, we make reference to the answer

(mailed July 29, 2003) for the examiner's complete reasoning in support of the rejection,

and to the brief (filed April 14, 2003) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to

the appellants' specification and claims, to the applied prior art reference, and to the

respective positions articulated by the appellants and the examiner. As a consequence

of our review, we make the determinations which follow.

Anticipation is established only when a single prior art reference discloses,

expressly or under the principles of inherency, each and every element of a claimed

invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221

USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between

the claimed invention and the reference disclosure, as viewed by a person of ordinary

skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc.,

927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Claim 19, the only independent claim on appeal, reads as follows:

> A method for a user at an automatic teller machine to obtain securities information and transactions, comprising:
> the user accessing the automatic teller machine;
> the automatic teller machine prompting the user with an option to perform securities functions;
> the user selecting the option to perform securities functions;
> automatically prompting the user to select a securities function from a securities function group of obtain information, buy securities, and sell securities;
> the user selecting a securities function from the securities function group;
> **if the user selects the securities function of obtain information, automatically prompting the user to select one information type from an information type group of holdings, stock quotes, symbol directory, and activity and orders;**
> the user selecting an information type from the information type group; providing to the user information for the selected information types;
> **if the user selects one securities function from the securities function group of buy securities and sell securities, automatically determining whether the user has established a linked brokerage account;**
> **if the user has established a linked brokerage account, automatically determining whether the user has multiple brokerage accounts;**

**if the user does not have multiple brokerage accounts, automatically
presenting the user with a portfolio profile message;**
automatically determining whether a broker system is available;
**if a broker system is available, automatically determining whether
trading is enabled; and**
performing a trading request for enabled trading. [Emphasis ours]

The LA Times Article discusses that Citibank is the first to offer full-scale
brokerage services at automatic teller machines (ATMs). Citibank's brokerage
customers can now use its ATMs to buy and sell stocks and to get market values for
securities. The Citibank system relies on specially designed ATMs that have separate
"menus" for banking and brokerage services. Customers who want to access their
stock account will select a button that says "brokerage services: Not FDIC insured."
The screen then offers a choice between information or trading. If the customer
chooses to trade, the next screen is a full-page of disclosure about stock market risks.
If the customer just wants to check stock prices the system will pull up a picture of a
typewriter keyboard. By touching the screen, the customer can type in the name of the
company or its ticker symbol and get a real-time stock quote or the previous day's
mutual fund closing price.

The appellants argue (brief, pp. 4-6) that the LA Times Article does not anticipate
claim 19 since the limitations highlighted above are not disclosed therein. We agree.

While the Citibank system described by the LA Times Article does allow a user

at an ATM machine to perform securities functions of obtaining information and trading

(i.e., buy and sell) securities, the Citibank system, as disclosed in the LA Times Article,

does not automatically prompt the user to select one information type from an

information type group of holdings, stock quotes, symbol directory, and activity and

orders when the user selects the securities function of obtaining information. Likewise,

the specific steps set forth in claim 19 that occur when the user selects the securities

function group of buy securities and sell securities are not disclosed by the Citibank

system described by the LA Times Article. Thus, the Citibank system described by the

LA Times Article does not anticipate claim 19.

The examiner's belief (answer, p. 5) that the Citibank system described by the

LA Times Article "teaches all the positive limitations" set forth in claim 19 is clearly in

error. All limitations of claim 19 are positive limitations that must be disclosed by the

Citibank system described by the LA Times Article in order to anticipate claim 19. The

examiner has not properly treated the limitations highlighted above. Instead, the

examiner has dismissed these limitations as being "alternative, conditional limitations."

Such is not the case. Claim 19 is a method claim requiring a system that is capable of

performing each of the recited method steps. The Citibank system described by the LA
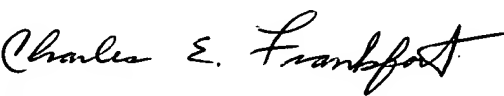
Times Article does not describe a system that is capable of performing each of the method steps recited in claim 19 as pointed out by us in the preceding paragraph.

For the reasons set forth above, the decision of the examiner to reject claim 19, and claims 20 to 37 dependent thereon, under 35 U.S.C. § 102(a) is reversed.
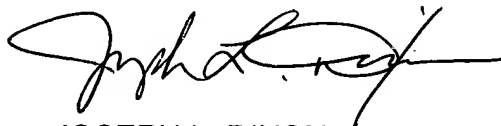
CONCLUSION

To summarize, the decision of the examiner to reject claims 19 to 37 under 35 U.S.C. § 102(a) is reversed.

REVERSED

CHARLES E. FRANKFORT)
Administrative Patent Judge)
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) BOARD OF PATENT
JEFFREY V. NASE) APPEALS
Administrative Patent Judge) AND
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